

No. 95-26

(24)

Supreme Court, U.S.

FILED

DEC 8 1995

CLERK

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN and POSITEK, INC.,
v. *Petitioners,*

WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,
Respondents.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

**BRIEF AMICUS CURIAE OF
INTELLECTUAL PROPERTY OWNERS
IN SUPPORT OF RESPONDENTS**

CONSTANTINE L. TRELA
JAMES B. SPETA
SIDLEY & AUSTIN
One First National Plaza
Chicago, Illinois 60603
(312) 853-7000

REX E. LEE
CARTER G. PHILLIPS *
MARK E. HADDAD
SIDLEY & AUSTIN
1722 Eye Street, N.W.
Washington, D.C. 20006
(202) 736-8000

Counsel for Amicus Curiae

December 8, 1995

* Counsel of Record

WILSON - EPES PRINTING CO., INC. - 789-0096 - WASHINGTON, D.C. 20001

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**BRIEF AMICUS CURIAE OF
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IN SUPPORT OF RESPONDENTS**

INTEREST OF AMICUS CURIAE

With the consent of the parties,¹ the Intellectual Property Owners ("IPO") hereby submits this brief *amicus curiae* in support of respondents. Although neither IPO nor any of its members has a direct interest in the outcome of this case on the merits, IPO and its members have a substantial interest in the issue presented for review by this Court. Many of IPO's members are patent owners and assignees, and the method by which those patents are construed is a fundamental concern to those members. The Federal Circuit's decision rationalizes the con-

¹ Letters reflecting the parties' consent to the filing of this brief have been filed with the Clerk of the Court.

struction of patent claims by recognizing that such construction always involves questions that are solely matters of law. This holding not only is commanded by patent law but also will promote the consistency and uniformity necessary both for patent owners and the public. Although IPO does not in this brief address the parties' contentions based upon the practice of claim construction at common law, IPO believes that the statutory requirements of current patent law preclude any role for the jury in the claim construction process.

IPO is a national organization founded in 1972 which represents the interests of owners of intellectual property in the United States. IPO's members currently include nearly 100 large and mid-size companies and more than 300 small businesses, universities, independent inventors, authors, executives and attorneys who own or are interested in patents, trademarks, copyrights and other intellectual property rights. Members of IPO's Board of Directors, which pursuant to IPO's by-laws approved the position taken in this *amicus* brief by a three-fourths vote, are listed in the Appendix to this brief. IPO is a non-profit association exempt from federal income tax under Internal Revenue Code § 501(c)(6).

INTRODUCTION AND SUMMARY OF ARGUMENT

The Federal Circuit's *en banc* decision that the construction of patent claims is exclusively a matter of law for the court at last harmonizes the process of claim construction with the patent laws' substantive claiming requirements and the canons of patent claim construction dictated by the Patent Clause of the Constitution and the patent statutes. The Federal Circuit properly held that claim construction is a matter of law for the court notwithstanding the need, in some cases, for a court to consider "extrinsic evidence," including expert testimony. The patent laws require that each patent's claims be set out clearly, to provide notice to those skilled in the rele-

vant art of what invention the patent protects, and that the Patent Office make an affirmative finding that a patent application presents an invention patentable under the statutory criteria that is claimed with the requisite precision. By virtue of these dual requirements, although extrinsic evidence occasionally may be needed to illuminate claim terms, construction should never devolve to an indeterminate "choice" between conflicting reasonable interpretations of the claims. There is, therefore, no role for a jury (or other factfinder) to play in the process of claim construction.

1. The Federal Circuit properly held that interpretation of patent claims is a matter for the court, notwithstanding that the patentee has sued for damages and that the Seventh Amendment therefore guarantees the parties the right to a jury trial on the merits of the infringement claim. The Federal Circuit also properly recognized that courts often would be required to consider matters outside the four corners of the patent's claims and specification, such as the prosecution history of the patent and evidence defining the state of the art at the time the patent was issued. The Federal Circuit moreover recognized that expert testimony could prove useful to illuminate the meaning of claim terms in light of the relevant state of the art.

Petitioners' attack on the Federal Circuit's holding turns on the argument that consideration of extrinsic evidence, especially expert testimony and especially where such evidence may be disputed, necessarily converts some or all of the claim construction process into a "factual" inquiry that the Seventh Amendment requires a jury to decide. This argument presumes that, once an action has been identified as one that gives rise to a right to jury trial under the Seventh Amendment, each and every "factual issue" (as petitioners and their *amici* have defined such issues) must be determined by the jury and subject to deferential review by appellate courts.

Petitioners' underlying presumption is false, for there are numerous issues in every jury case that the court decides. Among these issues are: questions of jurisdiction; questions of transfer, forum *non conveniens* and choice of law; questions of foreign law (*see* FED. R. CIV. P. 44.1); and, in rare but permissible instances, statutory construction. The Seventh Amendment does not require that the factual predicates of these issues, even where disputed, be submitted to the jury. Although not all of the possible Seventh Amendment issues have been definitively resolved by this Court, in each of these contexts, the consensus of the courts of appeals that have squarely faced these issues is that the Seventh Amendment does not require that the disputed facts be decided by the jury. And this Court, in approving Federal Rule of Civil Procedure 44.1, permitted courts to "consider any relevant material or source, including testimony" in order to rule on questions of foreign law. FED. R. CIV. P. 44.1. Therefore, petitioners' characterization of the Federal Circuit's decision as anomalous simply because it identifies claim construction disputes as matters for the court to decide before submitting the merits of the ultimate question of infringement to the jury is erroneous.

2. Congress' substantive requirement in the patent laws that a patent claim the protected invention in precise terms, and Congress' commitment of primary responsibility over the patent process to an expert administrative agency, together create a structure under which the jury has no appropriate role in construing patent claims. The patent laws require that patent claims be clearly and precisely stated. This requirement serves two fundamental purposes. First, it apprises the public of the advance that the patentee has made beyond the then-existing state of the art, so that the public may use the invention after the patentee's limited monopoly expires. This, in fact, is the fundamental *quid pro quo* of the patent laws: The in-

ventor receives a limited, exclusive right to exploit the invention in order to encourage the advance of the sciences generally. Second, the requirement that patent claims be clearly and precisely stated ensures that the patentee enjoys the full scope of this monopoly, but also simultaneously provides other practitioners of the art, and the public generally, notice of the precise boundaries of the protected invention so that they may avoid infringement.

Congress, in the exercise of the power the Constitution grants it to establish patents, has statutorily defined the criteria of patentability. Moreover, because of the technical, specialized questions involved in determining patentability, Congress has simultaneously committed initial and primary responsibility for the patent process to an expert administrative agency, the Patent and Trademark Office ("PTO"). Patent applicants must submit to the PTO with their applications a review of the state of the art, and the PTO must conduct an examination to determine both that an invention is patentable and that the patent claims are clearly stated. Although private parties may contest the validity of patents in subsequent litigation, either as a defense to an infringement suit or in an action seeking a declaratory judgment of invalidity, Congress has recognized the primacy of the PTO's determinations by according patents a presumption of validity such that only clear and convincing evidence can justify a finding of invalidity. The findings of the PTO are embodied in the patent's claims, and those claims therefore are most properly analogized to a statute, as the Federal Circuit did in the decision below, or to an administrative agency's regulation.

These dual features of the patent laws demonstrate that no jury trial right exists on the issue of claim construction. The power of Congress to have created such a statutory scheme cannot be doubted. A patent is a right created pursuant to the authority vested in Congress by the Constitution, and the patent monopoly is a creature

of the public interest and not a matter of private property rights. Therefore, the granting, validity and construction of patents are matters of "public right" that Congress may, consistently with the Seventh Amendment, commit to administrative tribunals or to determination by a court without a jury.

ARGUMENT

I. THE USE OF EXTRINSIC EVIDENCE DOES NOT NECESSARILY CREATE A QUESTION FOR THE JURY.

As the Federal Circuit properly held in this case, the process of claim construction will sometimes require the court to consider evidence outside the four corners of the patent's claims and specifications. Petitioners and *amici* supporting petitioners rest their argument for reversal on the proposition that, in a case in which a jury trial is otherwise required, each and every question that requires the evaluation of extrinsic evidence presents an issue that a jury must decide. But that is not the law. There are numerous questions that the court decides in the context of a jury case, without turning to the jury for the underlying factfinding, that require or permit the consideration of extrinsic evidence.

The Federal Circuit's analysis begins with the proposition, which neither petitioners nor their *amici* dispute, that "[i]t has long been and continues to be a fundamental principle of American law that 'the construction of a written evidence is exclusively with the court.'" 26a (quoting *Levy v. Gadsby*, 7 U.S. (3 Cranch) 180, 186 (1805)). The Federal Circuit also holds, consistently with well-established patent law, that the construction of the written claims will nevertheless sometimes require consideration of material outside the four corners of the patent, including the prosecution history and expert testimony regarding the state of the art. 31a-34a. "This evidence may be helpful to explain scientific principles, the

meaning of technical terms, and terms of art that appear in the patent and prosecution history. Extrinsic evidence may demonstrate the state of the prior art at the time of the invention. It is useful 'to show what was then old, to distinguish what was new, and to aid the court in the construction of the patent.'" 32a-34a (quoting *Brown v. Piper*, 91 U.S. 37, 41 (1875)).

Petitioners and their *amici* take the position that the need to consider any extrinsic evidence necessarily requires that the claim construction decision be committed to a jury as trier of fact. See Pet. Br. 18 ("when a tribunal—judge or jury—resolves issues by considering testimony and evidence, . . . this is a classic issue—a factual dispute—to be submitted to the jury"); Litton Br. 10 ("[r]esolving disputes over [extrinsic evidence] produces a *factual* finding" that must be made by the jury). At bottom, this argument presumes that whenever the court must resort to extrinsic evidence to decide any aspect of a question of law, that issue, by virtue of the need to consider the extrinsic evidence, becomes one for the jury.

To the contrary, the need for "extrinsic evidence" cannot be the touchstone for determining whether the right to trial by jury under the Seventh Amendment is implicated. As an initial matter, the decision whether there is a right to a jury trial on a given claim for relief is made by reference to the status of such claims at common law and, more importantly, the nature of the relief sought. See *Tull v. United States*, 481 U.S. 412, 417-18 (1987); *Chauffeurs, Teamsters & Helpers Local No. 391 v. Terry*, 494 U.S. 558, 565 (1990). In deciding whether the action is one "at common law" to which the Seventh Amendment applies, the test does not require a court to consider whether the case involves issues on which the trial judge will hear or evaluate extrinsic evidence. Clearly, in a case in which the only claim is a patentee's request for an injunction preventing infringement, the process of claim construction is identical to that in a damages case, and yet the Seventh Amendment does not require that a jury

be empaneled to hear the evidence.² See generally *Ross v. Bernhard*, 396 U.S. 531, 535 (1970) (solely equitable causes of action present "no Seventh Amendment problems").

Moreover, even in cases in which the Seventh Amendment requires that a claim be tried to a jury, there are numerous ancillary legal issues that the court decides as to which the judge is permitted or required to evaluate extrinsic evidence. *Amicus* Litton Systems contends that the only inquiry the Seventh Amendment requires is whether a "lawsuit fall[s] inside or outside the historic category of 'suits at common law,'" and that, if the "lawsuit" requires a trial by jury, then the Seventh Amendment further requires that all "factual disputes" that arise in the lawsuit be decided by the jury. See *Litton Br.* 10-11. To the contrary, as numerous examples demonstrate, it is neither "entirely novel" nor "incompatible with the Seventh Amendment" to decide that certain "factual disputes, embedded within lawsuits undeniably falling inside the historic jury-trial category, nonetheless appear so 'legal' in character that those facts may be decided by the court rather than the jury." *Id.* at 11 (emphasis and footnote omitted). As Professor Moore states, "While most actions of a legal nature are triable to a jury on timely demand, . . . not all issues of fact in a legal action are so triable." 5 MOORE'S FEDERAL PRACTICE ¶ 38.38[4], at 38-359 (1988).³

² It is true, as petitioners point out and *amicus* Litton Systems elaborates (*Pet. Br.* 31 n.16; *Litton Br.* 12-15), that the Seventh Amendment contains "two clauses." But the Reexamination Clause constricts appellate review only of those "fact[s] tried by jury." U.S. CONST. amend. VII. It therefore brings nothing independent to the question whether a given fact must be "tried by jury."

³ This Court, albeit in the converse context of recognizing a right to a jury where a stockholder's derivative action (traditionally brought in equity) presented a legal claim against the defendant directors and officers, explicitly rejected the notion that a determination at the level of the action resolved all of the Seventh Amendment questions. "The Seventh Amendment question depends

Courts, for example, determine their own jurisdiction; jurisdiction is not a factual matter committed to decision by the jury, even where the determination involves the resolution of disputed facts. This Court reiterated in *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 561 (1992), that, at each stage of the litigation, beginning with the pleading stage and progressing through an ultimate factual showing, the plaintiff must demonstrate standing to bring an action. But even though such jurisdictional determinations often require "full development of the relevant facts" (see *Bender v. Willamsport Area School Dist.*, 475 U.S. 534, 541 (1986)), this Court has never held that a jury periodically must be empaneled to find the facts on standing. To the contrary, this Court has held that the determination whether the parties are diverse, which undoubtedly involves an underlying factual issue, is one that need not be submitted to the jury. See *Gilbert v. David*, 235 U.S. 561, 567 (1915) ("while the court might have submitted the question to the jury, it was not bound to do so, the parties having adduced their testimony, pro and con, it was the privilege of the court, if it saw fit, to dispose of the issue upon the testimony which was fully heard upon that subject") (citing *Wetmore v. Rymer*, 169 U.S. 115 (1898)); see also *McNutt v. General Motors Acceptance Corp.*, 298 U.S. 178, 186 (1936); *Williamson v. Tucker*, 645 F.2d 404, 412-13 (5th Cir.), cert. denied, 454 U.S. 897 (1981); *Gough v. Rossmoor Corp.*, 487 F.2d 373, 377 (9th Cir. 1973). And, the court decides whether the plaintiff meets any jurisdictional amount requirement, without subsidiary

on the nature of the issue to be tried rather than the character of the overall action." *Ross*, 396 U.S. at 538; see also *Simler v. Conner*, 372 U.S. 221, 223 (1963); 9 CHARLES A. WRIGHT & ARTHUR R. MILLER, *FEDERAL PRACTICE AND PROCEDURE* § 2302, at 20 (1981) ("[T]he basic decisional unit in determining the existence of a right to jury trial is not the case. It is the particular issue within a case on which a jury trial is demanded."). Compare *FED. R. CIV. P.* 38(b) (jury trial on "any issue triable of right by a jury") (emphasis added).

factfinding by the jury. *North Pacific Steamship Co. v. Soley*, 257 U.S. 216, 221-23 (1921); *McNutt*, 298 U.S. at 186-87.

Issues unrelated to jurisdiction are similarly decided, sometimes on the basis of extrinsic evidence, by the court without aid of the jury. For example, transfer, forum *non conveniens* and choice of law decisions often turn on which of two or more states has more "contacts" or greater "interest" in the events giving rise to the litigation. In a typical contract case, for example, the choice of law determination will include consideration of where the contract was negotiated, formed and performed, among other things. See generally RESTATEMENT (SECOND) OF CONFLICTS OF LAW § 188. These questions often cannot be answered by consideration of the written documents alone, and yet there is no right to have a jury determine these underlying facts. In *Chance v. E.I. DuPont de Nemours & Co.*, 57 F.R.D. 165 (E.D.N.Y. 1972), Judge Weinstein held that factual issues relating to choice of law bearing on transfer and severance issues need not and should not be submitted to a jury. "Since the jury will still determine the ultimate facts on the merits, preliminary judicial resolution of the factual issues relevant to choice of law does not impinge upon the right to jury trial." *Id.* at 171; see also *Vaz Borralho v. Keydril Co.*, 696 F.2d 379, 386-89 (5th Cir. 1983) (district court entitled to decide choice of law and forum *non conveniens* issues without jury, notwithstanding that there were contested issues of fact). But cf. *Marra v. Bushee*, 447 F.2d 1282 (2d Cir. 1971) (jury required to decide disputed issue of situs of the tortious activity, determining choice of law).

One of the most telling areas in which the court determines a question of law and often employs expert testimony, learned treatises, and other "extrinsic" evidence is the determination of questions of foreign law under Federal Rule of Civil Procedure 44.1. From the

time this Court adopted Rule 44.1 in 1966, the determination of foreign law in the federal courts has been a question of law. FED. R. CIV. P. 44.1. Anglo-American courts and commentators, however, historically had treated the determination of foreign law as a question of fact. See, e.g., *Walton v. Arabian Am. Oil Co.*, 233 F.2d 541, 543 & n.6 (2d Cir.) (collecting cases), *cert. denied*, 352 U.S. 872 (1956). As a question of fact, foreign law had to be pleaded and proved by the party whose cause of action or defense depended upon it, proof offered was subject to the rules of evidence, and findings were reviewed under the deferential standards applicable to factual findings. John R. Brown, *44.1 Ways To Prove Foreign Law*, 9 MARITIME LAW, 179, 181 (1984).

Professor Miller suggests that the characterization of foreign law issues as questions of fact prior to Rule 44.1 reflected the practice of the English common law courts. The treatment of foreign law as a question of fact, he writes,

was a natural product of the high degree of jurisprudential isolation afforded by the English Channel, the concept that trial by jury required trial *per pais*, which called for a jury whose members were drawn from the vicinage where the facts occurred and theoretically had no cognizance of matters beyond their own locale, and the insistence that all causes fit within the existing, highly stylized forms of action.

Arthur R. Miller, *Federal Rule 44.1 and the "Fact" Approach To Determining Foreign Law: Death Knell for a Die-Hard Doctrine*, 65 MICH. L. REV. 613, 618 (1967). American courts adopted this common law view of treating foreign law issues as questions of fact, and probably perpetuated that view in part because foreign law materials were not readily available. *Id.* at 619.

Federal Rule of Civil Procedure 44.1 ended this practice in federal courts and provides that "[t]he court's determination" of foreign law "shall be treated as a ruling

on a question of law.”⁴ Notwithstanding that, under Rule 44.1, courts determine foreign law as a matter of law, courts may (and often do) consider extrinsic evidence, including testimony. Indeed, the Rule itself states that the court, “in determining foreign law, may consider any relevant material or source, including testimony, whether or not submitted by a party or admissible under the Federal Rules of Evidence.” FED. R. CIV. P. 44.1. Even though this testimony may require courts to make credibility determinations, there never has been any suggestion, either by this Court when it adopted Rule 44.1 or by courts or commentators since then, that judicial consideration of testimony regarding the content of foreign law violates the Seventh Amendment.⁵ That petitioners’ and their *amici*’s position requires the conclusion that this Court in 1966 adopted a facially unconstitutional Federal Rule of Civil Procedure makes plain that their theory is fundamentally flawed.

Courts have even used expert testimony and evidence other than traditional legislative history to assist in the construction of statutes and regulations, where the statutes contained terms of art or where the court needed assistance in interpreting the regulations. These few examples arose in actions without juries, but further demonstrate that petitioners’ reliance on extrinsic evidence as the touch-

⁴ Rule 44.1 provides in whole:

A party who intends to raise an issue concerning the law of a foreign country shall give notice by pleadings or other reasonable written notice. The court, in determining foreign law, may consider any relevant material or source, including testimony, whether or not submitted by a party or admissible under the Federal Rules of Evidence. The court’s determination shall be treated as a ruling on a question of law.

FED. R. CIV. P. 44.1.

⁵ Professor Miller concludes that judicial determination of foreign law does not violate the Seventh Amendment. Miller, 65 MICH. L. REV. at 684-88.

stone for the existence of factual issues requiring jury determination is erroneous. Petitioners do not dispute that statutory construction is always a question of law, and whatever interpretative aid a court employs cannot alter that conclusion. See, e.g., *United States v. Edge*, 989 F.2d 871, 876-79 (6th Cir. 1993) (court considered expert testimony of botany professor as to meaning of term “plant” in sentencing guideline); *MGPC, Inc. v. Canadian Hidrogas Resources, Ltd.*, 725 F.2d 1376 (TECA) (use of expert testimony to interpret pricing regulations), *cert. denied*, 464 U.S. 961 (1983); *Standard Oil Co. v. Department of Energy*, 596 F.2d 1029 (TECA 1978) (trial court looked to agency correspondence and memoranda for assistance in interpreting regulations). Petitioners are simply incorrect, therefore, that “no court would permit . . . experts[] to present testimony about the meaning of a statute.” Pet. Br. 45.

These examples demonstrate that, even in the context of a lawsuit to which a right to jury trial attaches, numerous legal issues arise that may involve factual disputes and resolution of those disputes need not be committed to the jury. These examples also demonstrate that the Federal Circuit’s decision in this case does not ignore *Dairy Queen, Inc. v. Wood*, 369 U.S. 469 (1962), and *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500 (1959), in which this Court held that issues of fact common to jury and nonjury questions must be submitted to the jury to preserve the parties’ Seventh Amendment rights. See Pet. Br. 21; Litton Br. 11-12. Even assuming that a court cannot resolve an “underlying factual question on an issue of law that is intertwined with the “merits” questions properly committed to the jury, compare 5 MOORE’S FEDERAL PRACTICE ¶ 38.36 [2.-2], at 38-335 to 38-336, that proposition does not implicate the Federal Circuit’s decision. Similarly, although claim construction might have “dispositive” impact on the question of infringement (Pet. Br. 17 n.8)—just as determinations of foreign law might have

dispositive impact in cases governed by such law or choice of law might have dispositive impact if the choice, for example, has statute of limitations consequences—that does not mean there are any “factual” questions in common between the construction question and the issue of infringement. In fact, there are not. Once the patent has been properly construed, the central factual issue presented by an infringement claim is the comparison between the patented invention and the allegedly infringing device or process. That factual issue remains an independent jury question.

In sum, the Federal Circuit’s decision is not “sleight of hand,” nor is it a “recharacterization” of a question of fact into a question of law by *ipse dixit* (Pet. Br. 21), any more than was this Court’s adoption of Federal Rule of Civil Procedure 44.1. It is, instead, perfectly consistent with judicial resolution of numerous other legal issues in jury cases. Questions of statutory construction are inquiries into the sovereign acts of a coordinate branch of government, and questions of foreign law likewise attempt to identify the sovereign acts of a foreign government. Similarly, jurisdictional questions are addressed to the court’s authority, as delimited by the Constitution and Acts of Congress, over the controversy before it. Properly conceived, claim construction is akin to these inquiries because the court is required to determine the action taken by the United States Patent and Trademark Office in granting, pursuant to constitutional and statutory standards, the limited patent monopoly. *See Part II, infra.*

II. BECAUSE THE PATENT LAWS REQUIRE THAT PATENT CLAIMS STATE PRECISELY THE NEW INVENTION AS DETERMINED BY THE PATENT AND TRADEMARK OFFICE, CLAIM CONSTRUCTION IS IN EFFECT THE PROCESS OF DETERMINING WHAT ACTION THE PATENT OFFICE TOOK AND THEREFORE INCLUDES NO ROLE FOR THE JURY IN DETERMINING “FACTS.”

1. As the Federal Circuit recognized, the patent laws require that a patent describe, in clear terms, the claimed invention. This fundamental requirement informs the public both of the advance the inventor has made, which is the *quid pro quo* for the temporally limited monopoly granted to the inventor, and of the scope of the monopoly so that infringement might be avoided. A patent that does not set forth its claims in sufficiently clear terms is void, and the interpretation of any patent whose claims are susceptible of more than one construction by those skilled in the relevant art is governed by well-established rules of claim construction derived from the patent laws themselves. There is, therefore, no role for the jury, or other finder of fact, to choose between disputed interpretations of patent claims.⁶

It is a fundamental tenet of patent law that, “[b]y statute, the patent must provide a written description of the invention that will enable one of ordinary skill in the art to make and use it.” 27a. The statute provides, in relevant part:

The specification shall contain a written description of the invention, and of the manner and process

⁶ IPO concedes that the weight of authority in the Federal Circuit prior to the decision in this case stated, albeit without any substantial analysis, that there were “factual” questions underlying the “legal” issue of claim construction. *See* Pet. Br. 17-18 & n.9. That authority, which was by no means uniform, *see* 25a (collecting cases), adds nothing to petitioners’ argument in this Court.

of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

35 U.S.C. § 112.

As this Court has held on numerous occasions, the claims are the measure of the patent's scope. Everything claimed, if it is rightfully patentable, is protected; everything not claimed, even if it would have been patentable by the inventor, is not protected, but is dedicated to the public. In *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274 (1877), this Court wrote that the claiming requirement of section 112, added by the patent law revision of 1836, meant that the "scope" of a patent's claim "always should be . . . clear and distinct." *Id.* at 278; see also *McClain v. Ortmyer*, 141 U.S. 419, 424 (1891) ("The claim is the measure of [the patentee's] right"); *O'Reilly v. Morse*, 56 U.S. (15 How.) 61, 119 (1854). The Court in *Keystone Bridge* also held that the claiming provision was intended to put an end to judicial uncertainty as to (and judicial inquiry into) the scope of a patentee's claim. "This provision was inserted in the law for the purpose of relieving the courts from the duty of ascertaining the exact invention of the patentee by inference and conjecture." *Keystone Bridge*, 95 U.S. at 278. As this Court said as early as 1876: "The developed and improved condition of the patent law, and of the principles which govern the exclusive rights conferred by it, leave no excuse for ambiguous language or vague descriptions." *Merrill v. Yeoman*, 94 U.S. 568, 573 (1876). Therefore, although the statute requires sufficient clarity

to instruct one skilled in the art (as contrasted with lawyers or judges) in the patent and the scope of the claimed invention, see *Carnegie Steel v. Cambria Iron Co.*, 185 U.S. 403, 437 (1902); Pet. Br. 17; Litton Br. 8, 25, the claiming requirements also ease construction by the courts, which can be instructed in the art (*inter alia*, by experts).

This requirement that a patent's claims precisely describe the invention is imposed for dual purposes. On the one hand, it ensures that the patentee gains protection for the new and valuable aspects of the invention—*i.e.*, the advances in the "Progress of Science and useful Arts" (U.S. CONST. art. I, § 8, cl. 8)—and, on the other hand, it ensures that the public is provided notice of the monopoly given to the inventor so that infringement can be avoided. "The object of the patent law in requiring the patentee to 'particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery' is not only to secure to him all to which he is entitled, but to apprise the public of what is still open to them." *McClain v. Ortmyer*, 141 U.S. 419, 424 (1891); *Merrill*, 94 U.S. at 573 ("The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights."). The specification and claiming requirements also serve the public interest by requiring the inventor, as a condition of the grant of the patent, to inform the community of the invention "in sufficient detail to enable one skilled in the art to practice the invention once the period of the monopoly has expired." *Universal Oil Products Co. v. Globe Oil & Refining Co.*, 322 U.S. 471, 484 (1944); compare also *id.* ("the same precision of disclosure is likewise essential to warn the industry concerned of the precise scope of the monopoly asserted").

As adjuncts to the claiming requirements, the courts have developed clear standards to determine the scope of a claim that is not precisely stated. First, if the patent fails to comply with the statute altogether and fails to state the

invention claimed in detail sufficient to permit a person skilled in the art to ascertain the claimed invention, then the patent is void. See *Brooks v. Fiske*, 56 U.S. (15 How.) 212, 214-15 (1854); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1575-76 (Fed. Cir. 1986); *In re Corkill*, 771 F.2d 1496 (Fed. Cir. 1985). Second, if the claims do state some patentable invention, the court construes the scope of the patent to preserve the invention in light of the state of the art existing at the time the patent application was made. See generally *McClain*, 141 U.S. at 425 ("where the claim is fairly susceptible of two constructions, that one will be adopted which preserves to the patentee his actual invention"); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 361-61 (1854). More specifically, a patent claim in a "crowded field," which makes a small advance on the state of the art, will be construed narrowly. See generally *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 63 (1923) ("If what he has done works only a slight step forward, . . . then his patent, if sustained, will be given a narrow scope"); *Cimotti Unhairing Co. v. American Fur Refining Co.*, 198 U.S. 399, 406-09 (1905). And conversely, a "pioneer" patent will be given a broad construction, to preserve for the inventor the maximum protection for his exceptionally innovative invention. *Eibel Process Co.*, 261 U.S. at 63; *Texas Instr. v. United States ITC*, 805 F.2d 1558, 1562 (Fed. Cir. 1986).

Nevertheless, the fundamental rule is that a patent cannot be given a meaning that does not provide persons skilled in the relevant art notice of the monopoly. For example, in *Mercoird Corp. v. Mid-Continent Inv. Co.*, 320 U.S. 661 (1944), the Court tied this narrowing rule of interpretation to the public interest upon which the entire patent system is based. "It is the protection of the public in a system of free enterprise which alike nullifies a patent where any part of it is invalid and denies to the patentee after issuance the power to use it in such a way as to

acquire a monopoly which is not plainly within the terms of the grant." *Id.* at 665-66 (citations omitted); see *McClain*, 141 U.S. at 425.

Acting in combination, the claiming requirements of section 112 and the attendant rules of construction dictate that a court will not "choose" between competing reasonable interpretations of patent claims. In those rare situations in which the extrinsic evidence does not yield a single interpretation,⁷ the court will either declare the patent void for insufficient claiming or will select the appropriate interpretation in accord with the rules of construction. There is, in these circumstances, no "choice" between competing interpretations of the patent claims, and no factual issue to be resolved by a jury.

2. Congress has committed initial and principal responsibility for administration of the patent system to the Patent and Trademark Office. Pursuant to the governing statutes and regulations, a patent applicant must specify and claim his invention in a way that demonstrates its patentability, and the PTO must conduct an examination to determine that the invention is patentable and is clearly and precisely claimed. Thus, section 111 requires that an application for a patent be made to the Commissioner of the PTO, section 112 requires that the new advance be specified and precisely claimed, and section 131 requires the PTO to conduct "an examination . . . of the application and the alleged new invention." 35 U.S.C. §§ 111, 112, 131. "[I]f on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor." *Id.* § 131.

⁷ Of course, where the extrinsic evidence yields only a single reasonable interpretation of a written document, there is no issue for the jury in any event. Compare RESTATEMENT (SECOND) OF CONTRACTS § 212(2) ("A question of interpretation of an integrated agreement is to be determined by the trier of fact if it depends on the credibility of extrinsic evidence or on a choice among reasonable inferences to be drawn from extrinsic evidence. Otherwise a question of interpretation of an integrated agreement is to be determined as a question of law.").

The attendant regulations require that an applicant submit to the Patent Office all information which is "material to patentability," 37 C.F.R. § 1.56(a), including all prior art references necessary to establish the state of the art and the patentability of the invention claimed. *See also generally* 37 C.F.R. § 1.51 *et seq.* (required details of application).

The applicable regulations make clear the duty of the PTO to inquire into all questions of patentability and compliance with the patent laws.

On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

37 C.F.R. § 1.104(a). Indeed, through the device of an "examiner's amendment," the examiner may not only determine that claim language complies with statutory requirements but may himself propose specific claim language. *See* 48a; *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 659 (Fed. Cir. 1986) ("the purpose of the examiner's amendment, as expressly stated, was to more particularly point out the invention"). In either event, the Manual of Patent Examining Procedure provides that the examiner shall assure that the claims meet the clarity requirements of the statute: "The examiner has the responsibility to make sure the wording of the claims is sufficiently definite to reasonably determine the scope." Manual of Patent Examining Procedure § 706.03(d) (Revision 16, 1990).

Congress has affirmed the primacy of the PTO's determination of patentability and compliance with the stat-

ute's other requirements by providing that "[a] patent shall be presumed valid." 35 U.S.C. § 282. The courts, recognizing the PTO's primary role, have further held that only clear and convincing evidence can establish a patent's invalidity in the face of the statutory presumption. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1549 (Fed. Cir. 1983). *Compare also* *Graham v. John Deere Co.*, 383 U.S. 1, 18 (1966) ("the primary responsibility of sifting out unpatentable material lies in the Patent Office. To await litigation is—for all practical purposes—to debilitate the patent system."); *Intervet America, Inc. v. Kee-Vet Labs., Inc.*, 887 F.2d 1050, 1054 (Fed. Cir. 1989) ("The presumption of validity under 35 U.S.C. § 282 carries with it a presumption the examiner did his duty and knew what claims he was allowing.").

3. Given the highly structured nature of the patentability decisions made by the PTO as an expert agency, the Federal Circuit's analogy of patent construction to statutory interpretation is precisely on point. *See* 51a-52a. The affirmative judgment that the PTO makes upon examination and that is embodied in the approved and issued claims of the patent makes the subsequent judicial inquiry on claim construction a matter of determining what action the PTO took: *i.e.*, precisely what claim did the PTO approve and find patentable. None of the other questions of patent law to which *amicus* Litton Systems refers as threatened by the decision below (Litton Br. 17-18) involves a determination of what action was taken by the agency; each involves application of the principles of patent law to the patent *as approved by the PTO*.⁸

⁸ Although the patentee drafts the claims in the first instance, *see* 31a ("a patentee is free to be his own lexicographer"), the PTO process is different from that under the Copyright laws, where the Copyright Office, although it may reject clearly insufficient applications, is not required to (and does not) determine the copyrightability of works submitted. *See* H.R. REP. NO. 1476, 94th Cong., 2d Sess. 157 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659,

Moreover, the rules of patent claim construction (*see supra*, at 17-19) play the same role here as rules of statutory construction play in that context. *Compare* Litton Br. 23-24. *See* 28a ("it is only fair (and statutorily required) that competitors be able to ascertain to a reasonable degree the scope of the patentee's right to exclude. They may understand what is the scope of the patent owner's rights by obtaining the patent and prosecution history—the undisputed public record—and applying established rules of construction to the language of the patent claim in the context of the patent.") (citations omitted).

4. The Federal Circuit's decision will also promote uniformity and predictability in the process of patent interpretation, both as to each individual patent subjected to litigation and as to the process of patent construction generally. 28a-30a. Treating claim construction as a matter of law subject to *de novo* review by the Federal Circuit will require that the trial court clearly articulate its interpretation of the patent, which will provide both the parties to the litigation and interested nonparties notice as to the scope of the patent in suit. In contrast, in litigation in which both interpretation and infringement are submitted to the jury, the jury's interpretation of the patent

5773 ("unlike a patent claim, a claim to copyright is not examined for basic validity before a certificate is issued") (emphasis added); 2 NIMMER ON COPYRIGHT § 7.21[A] (1995); *Cadence Indus. Corp. v. Ringer*, 450 F. Supp. 59, 65 (S.D.N.Y. 1978) ("The Copyright Office has neither the facilities nor the authority to rule upon the factual basis of applications for registration"). The process of patent approval is also unlike that under the laws derived from the Interstate Commerce Act that require the filing of tariffed rates, where the filed tariffs become effective unless the agency disapproves them, *see* 49 U.S.C. §§ 10707-10708 (superseding in part 49 U.S.C. § 15); 47 U.S.C. § 204 (Communications Act); *United States v. SCRAP*, 412 U.S. 669, 697 (1973) ("Congress was aware that if the Commission did not act within the suspension period, then the new rates would automatically go into effect"). *See also supra*, at 20.

will not necessarily appear simply from its verdict for one of the parties.

Although as an issue of law, issue preclusion will not apply between district courts on the question of claim construction, *compare* Pet. Br. 38, any decision by the Federal Circuit will bind all of the district courts through *stare decisis*. Moreover, issue preclusion presently does not arise with any frequency with respect to issues of claim construction decided by juries (*compare id.* at 38 n.20), because collateral estoppel requires identifying the precise finding of the jury on claim construction. *Brubaker v. King*, 505 F.2d 534, 538 (7th Cir. 1974); 18 CHARLES A. WRIGHT, ET AL., FEDERAL PRACTICE AND PROCEDURE § 4417 (1981). Where the jury returns a verdict on infringement, its ultimate construction of the patent, which may have been one of the constructions offered by the parties or another construction altogether, is not readily apparent. And this problem cannot be solved by the use of special verdicts or interrogatories, *compare* Pet. Br. 40 n.21; Litton Br. 28 & n.44, because a special verdict or interrogatory cannot ask the jury to describe in narrative form its construction of the patent. *See* FED. R. CIV. P. 49(a) ("the court may submit to the jury written questions susceptible of categorical or other brief answer"). Moreover, even if the decision of a single district court does not bind subsequent district courts, the first court's written reasoning will be helpful to subsequent courts. Explicit construction of the claims by the court, as compared to implicit construction by a jury, will provide much needed notice to other participants in the relevant product or process market of the precise scope of the patentee's monopoly.

5. This approach presents no square conflict with prior decisions of this Court. As petitioners concede, none of this Court's cases "addressed the Seventh Amendment

explicitly." Pet. Br. 31.⁹ That is because this Court's prior holdings indicating that disputed facts must be tendered to the jury almost always arose in the context of the ultimate infringement question, such as comparing the equivalency of two products or processes, and not in the initial step of declaring what an individual patent's claims mean. See, e.g., *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 816 (1869); *Coupe v. Royer*, 155 U.S. 565, 574-79 (1895); *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453, 455-56 (1871); *Silsby v. Foote*, 55 U.S. (14 How.) 218, 225 (1853).

6. Finally, there can be no constitutional objection, as Litton Systems suggests, to Congress taking from the jury any role it might otherwise have had (for example, at common law) in construing patent claims. Litton Br. 24-25. Under *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33 (1989), Congress clearly has the power, notwithstanding the Seventh Amendment, to commit "the adjudication of [patent law issues to] a nonjury factfinder" because patents are public rights. *Id.* at 54. In *Granfinanciera*, the Court made clear that matters of public right do not arise only "between the government and others," but instead involve questions where "Congress, acting for a valid legislative purpose pursuant to its constitutional powers under Article I, has created a seemingly 'private' right that is . . . closely integrated into a public regulatory regime." *Id.* (citations omitted).

The patent laws are of course enacted pursuant to Congress' authority under Art. I, § 8, cl. 8 of the Constitution, and this Court has made clear on innumerable occasions that the underlying interest of the patent system, and of any patent grant, is the public interest, not the private rewards to an inventor. The private rewards are justified only by the benefit they provide to the public through incentives for the advancement of science. See

⁹ But see Litton Br. 15 (asserting that the decision below creates a "square conflict" with prior decisions of this Court).

Precision Instrument Mfg. Co. v. Automotive Maintenance Machinery Co., 324 U.S. 806, 816 (1945) ("A patent by its very nature is affected with a public interest. . . . The far-reaching social and economic consequences of a patent, therefore, give the public a paramount interest"); *Mercoind Corp. v. Mid-Continent Inv. Co.*, 320 U.S. 661, 665 (1944) ("It is the public interest which is dominant in the patent system."); *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 511 (1917) ("the primary purpose of our patent laws is not the creation of private fortunes for the owners of patents but is 'to promote the progress of science and useful arts'"); *Kendall v. Winsor*, 62 U.S. (21 How.) 322, 328 (1859) ("the benefit to the public . . . was . . . doubtless the primary object in granting and securing that monopoly"). To ensure that the public's interest is fully vindicated, the discrete legal issue of claim construction should be left to the courts. And nothing in the Seventh Amendment commands a different approach.

CONCLUSION

For all the foregoing reasons, the judgment of the court of appeals should be affirmed.

Respectfully submitted,

CONSTANTINE L. TRELA
JAMES B. SPETA
SIDLEY & AUSTIN
One First National Plaza
Chicago, Illinois 60603
(312) 853-7000

REX E. LEE
CARTER G. PHILLIPS *
MARK E. HADDAD
SIDLEY & AUSTIN
1722 Eye Street, N.W.
Washington, D.C. 20006
(202) 736-8000

Counsel for *Amicus Curiae*

December 8, 1995

* Counsel of Record

APPENDIX

APPENDIX

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